

APPLICANT'S REMARKS

1. Status of the Claims

Claims 1–4, 10–13, 15, and 16 are pending. Claims 6 and 17 are cancelled hereinabove.

2. Rejection of Claims 1–4, 10–13, 15, and 16 as being anticipated by TSIE

Claims 1–4, 10–13, 15, and 16 are rejected under 35 USC 102(b) as being anticipated by TSIE. The Examiner has acknowledged that SEQ ID NOs: 1 and 2 are “free of the art.” However, the Examiner is interpreting option c) of claims 1 and 15 as requiring “only a small region of the claimed nucleic acid molecule as being 95% homologous to SEQ ID NO: 1.” (emphasis added) Accordingly, the Examiner asserts that “at least a portion of the Tsien mutant GFP is 95% homologous to SEQ ID NO: 1, since the instant application teaches that Tsien GFP is 44% homologous to the instantly claimed GFP.” (emphasis added)

The Applicant respectfully disagrees with the Examiner's interpretation of option c) and submits that the Examiner's interpretation of option c) is unreasonable based on the plain meaning of option c).

The words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) “[T]he ordinary and customary meaning of a claim term is the

meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application."

Phillips v. AWH Corp., 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (en banc). Sunrace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)

Option c) plainly states "at least 95% homologous to SEQ ID NO:1." Neither the phrase "a small region" nor the phrase "a portion" appears in claim 1.

The plain meaning of option c) is consistent with the specification. In fact, the specification does not mention either the phrase "a small region" or the phrase "a portion."

Moreover, the Examiner provides no evidence for concluding that one of ordinary skill in the art at the time of the invention would interpret the phrase "at least 95% homologous to SEQ ID NO:1" to mean "at least 95% homologous to *only a small region or a portion* of SEQ ID NO: 1."

Based on the plain meaning of option c), the Applicant submits that TSIEN does not disclose or even suggest a nucleic acid molecule which is at least 95% homologous to SEQ ID NO:1.

Therefore, the Applicant submits that the §102(b) rejection of claims 1–4, 10–13, 15, and 16 based on TSIEEN should be be reconsidered and withdrawn.

3. Rejection of claims 6 and 17 as being anticipated by LEVINE

In light of the foregoing amendments to the claims, the Applicant respectfully submits that the §102(b) rejection of claims 6 and 17 based on LEVINE are moot and may be withdrawn.

4. Conclusion

The Applicant respectfully requests favorable consideration of this Amendment and the issuance of a Notice of Allowance.

Respectfully submitted,

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